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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,079	07/19/2003	Timo Burzel	(Z) 02111 P US	3305

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M. Robert Kestenbaum  
11011 Bermuda Dunes NE  
Albuquerque, NM 87111

EXAMINER

CLEMENT, MICHELLE RENEE

ART UNIT PAPER NUMBER

3641

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/623,079

Applicant(s)

BURZEL, TIMO

Examiner

Michelle (Shelley) Clement

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 14, 15, 21 and 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16-20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 14, 15, 21, and 23-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/14/05.

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the module arranged between the weapon and a telescope sight must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

3. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The module provided with a fastening device for mounting the system comprising a firearm and a telescopic sight is set forth in the previous claim.

4. Claim 5 is objected to because of the following informalities: The claim is apparently missing words or is otherwise grammatically incorrect. Appropriate correction is required.

5. Claim 7 is objected to because of the following informalities: The claim is apparently missing words or is otherwise grammatically incorrect. Appropriate correction is required.

6. Claim 18 is objected to because of the following informalities: There is insufficient antecedent basis for the limitation "the field of view of the eyepiece" in the claim. Appropriate correction is required.

7. Claim 22 is objected to because of the following informalities: There is insufficient antecedent basis for the limitation "the control device" in the claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 12 recites the limitation "the adjusting element" in line 2. There is insufficient antecedent basis for this limitation in the claim since applicant has not previously cited an adjusting element rendering the claims indefinite because it is not clear what the rotary element is intended to be provided as or what it adjusts. For the remainder of the action the examiner is presuming that applicant is referring to the adjusting element for adjusting the brightness of the indicator, as referenced in claim 11.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 4, 9, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Tarlton et al. (US Patent # 5,406,733). Tarlton et al. discloses an indicator device including a bubble spirit level that can be used with a firearm (reference 10) and telescopic sight (reference 20), the indicator device including an indicator and an inclination sensor that is calibrated with respect to a vertical axis, wherein the inclination sensor senses a deflection of the vertical plane with respect to the vertical axis, wherein a module is formed with the indicator device and is provided

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with a fastening device, including a clamp device (reference 22), that can be used to mount on a firearm and telescopic sight. A deflection with respect to the vertical axis is indicated by a display. It is further noted that inclination sensors, inclination sensors including indicators and the use of them with firearms is well known in the art. It is further noted that the [a)statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"]clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

13. Claims 1-11, 16, 18-20, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Williamson et al. PCT (WO 03/029745 A3). Williamson et al discloses an indicator device including an indicator and an inclination sensor that is calibrated with respect to any axis, including a vertical axis with which a vertical plane is associated, wherein the inclination sensor

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senses a deflection of the vertical plane with respect to the vertical axis (page 18, lines 15), a module is formed with an indicator device (Figure 7) and is provided with a fastening device and can be used to mount on a system comprising a firearm and a telescopic sight (Figure 4B). The indicator includes at least one lighting element that is a light emitting diode. A sensor emitting an electrical signal is provided as the inclination sensor, the electrical signal is supplied to a control device that is in signal connection with the indicator. The indicator can give a signal in different colors, wherein at least one of a direction and amount of a deflection from the vertical axis can be indicated by a different color. Plural lighting elements for indicating the direction of a deflection with respect the vertical axis may be provided. A deflection with respect to the vertical axis is indicated by a display. The deflection with respect to the vertical axis and the amount of a deflection may be indicated by a flashing signal. An adjusting element is provided for adjusting the brightness of the indicator. The module can be fastened to an eyepiece of the telescopic sight by a fastening device. Plural lighting elements are arranged coaxially of the field of view of the eyepiece. The module can be arranged between the weapon and a telescopic sight by clamps. The indicator device has a battery compartment. A control device is in signal connection with an element by the actuation of which an offset value, which is stored in a control device, can be established.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 12 and 13, as the examiner best understands them, are rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson et al. as applied to claim 1 above, and further in view of McGivern (US Patent Application 2003/0101604 A1). Although Williamson et al. does not expressly disclose the adjusting element for adjusting the brightness of the indicator comprising a rotary element wherein the rotary element has a rotation axis that is arranged perpendicularly of an optical axis of the telescopic sight, McGivern does. McGivern teaches controlling the brightness of indicators by using a rotary adjusting element, the element having a rotation axis that is arranged perpendicularly of an optical axis. McGivern and Williamson et al. are analogous art because they are from the same field of endeavor: sighting elements. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the rotary adjusting element as taught by McGivern with the tilt indicator of Williamson et al. The suggestion/motivation for doing so would have been to obtain a tilt indicator that had a simple adjusting mechanism.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Harms (US Patent # 5,878,504), Minghetti (US Patent # 2,331,616), Peterson (US Patent # 5,657,5710, Swartz et al. (US Patent # 4,503,622), Hopkins et al. (US Patent # 5,761,818), Dauerer (US Patent # 6,115,928), Pakus (US Patent # 4,654,977), Tan et al. (US Patent # 6,851,200), Edwards (US Patent # 6,813,025), Pinkley (US Patent # 6,813,855), Gurtner (US Patent # 6,862,833), Baltz (US Patent # 3,568,325), Hausenblas et al. (US Patent # 3,362,073), Ross (US Patent # 2,478,839), Finn (US Patent # 5,223,650), and Rusbach (US Patent # 4,214,372).



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "McClement", is located in the lower right quadrant of the page.